IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Wang, et al.	Examiner:	Ha, Julie.
Serial No.:	10/500,680		
Filed:	July 1, 2004	Group Art Unit:	1654
Entitled:	FORMULATION STRATEGIES IN STABILIZING PEPTIDES IN ORGANIC SOLVENTS AND IN DRIED STATES		
		Conf. No.:	3098

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Statement by Attorney to disqualify a reference under 35 U.S.C. 103(c)

Dear Sir:

Claims 29 and 30 of the above referenced application are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pan et al. (U.S. Patent No. WO/01/23420), as aplied to claims 17-18 and 22, in further view of Edmonson et al. (U.S. Patent No. 7,125,873) . Applicant seeks to disqualify the Pan et al. reference as prior art under 35 U.S.C. § 103(c)(1).

To disqualify a reference under 35 U.S.C. 103(c), applicant needs to supply evidence that the invention described in the application for patent and the invention described in the "prior art" reference applied against the application were commonly owed by, or subject to an obligation of assignment to, the same person, at the time the invention in the application for patent was made. The time requirement "at the time the invention was made" is required by statute. See 35 U.S.C. 103(c).

Applications and references will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to

an obligation of assignment to, the same person as required by 35 U.S.C. 103(c)," **1241 OG 96** (Dec. 26, 2000) and applies to applications filed on or after November 29, 1999 where a reference available under 35 U.S.C. 102(e) is sought to be excluded, and any application where a reference available under only 35 U.S.C. 102 (f) and/or (g) is sought to be excluded.

As noted above 103 rejection has been applied to claims 23-26 and 29-33 of the above referenced patent application, which was filed on or after November 29, 1999. Applicant hereby seeks to exclude the Pan et al. (WO01/23420), reference available under 102(e) pursuant to 35 U.S.C. 103(c).

Accordingly, the undersigned attorney for the instant Application 10/500,680, hereby states that:

Application 10/500,680 and WO01/23420 were, at the time the invention of Application 10/500,680 was made, commonly owned within the meaning of 35 U.S.C. §103(c).

According to the guidelines presented in **1241 OG 96** (Dec. 26, 2000), the phrase "same person" includes persons, organization(s) or corporation(s). If an invention claimed in an application is owned by more than one entity and those entities seek to exclude a reference's use under 35 U.S.C. 103, then the reference must be owned by, or subject to an obligation of assignment to, the same entities that owned the application, at the time the invention was made.

At the time the present application (Wang et al.) was filed (July 1, 2004), the claimed invention was subject to an obligation of assignment to Bayer Pharmaceuticals Corporation. An assignment of the Wang et al. application from the inventors to Bayer Pharmaceuticals Corporation was recorded in the U.S. Patent and Trademark Office on **February 12, 2003**, at **Reel/Frame 014722/0151**. As of January 1, 2008, the present application is assigned to Bayer HealthCare LLC, Tarrytown, NY, formerly being assigned to Bayer Pharmaceuticals Corporation.

At the time of filing of the Wang et al. application, the Pan et al. application was assigned to Bayer Corporation. Bayer Pharmaceuticals is a wholly owned subsidiary of Bayer Corporation and both Bayer Corporation and Bayer Pharmaceuticals Corporation are wholly owned subsidiaries of a parent company, Bayer AG. Thus, at the time of filing of the instant

application (Wang et al.), the two applications were owned by (or subject to an obligation of assignment to) subsidiaries of Bayer AG.

The definition of the term "commonly owned," as used in 35 U.S.C. §103(c)(1), is given in MPEP 706.02(l)(1). This section of the MPEP also provides Examples to illustrate scenarios relating to common ownership under 103(c). As shown in the Examples, a parent/wholly owned subsidary relationship is deemed common ownership. In particular, Example 1 is comparable to the instant situation. In Example 1, inventions A and B are made by inventors in Subsidiary A and Subsidiary B, respectively. Parent Company owns 100% of Subsidiaries A and B. In this case, inventions A and B are deemed to be commonly owned by the Parent Company.

Similarly, the Pan et al. and Wang et al. inventions were commonly owned, for purposes of 35 U.S.C. §103(c)(1), at the time of filing of the Wang et al. application because both Bayer Corporation and Bayer Pharmaceuticals Corporation are wholly owned subsidiaries of a parent company, Bayer AG. Accordingly, the Pan et al. patent is disqualified as prior art under 35 U.S.C. §103(c)(1).

Respectfully submitted,

Dated: 7/7/08

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